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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,578	12/03/2001	Masaaki Uenaka	2001-1736 A	5933

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EXAMINER

SMALL, ANDREA D SOUZA

ART UNIT PAPER NUMBER

1626

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/980,578	Applicant(s) UENAKA ET AL.	
	Examiner Andrea D Small	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,21 and 50-56 is/are pending in the application.
- 4a) Of the above claim(s) 50-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 50-56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

I. Preliminary Matters:

- (a) Applicant's response filed 3/31/2003 has been received and entered as paper no. 8.
- (b) Applicants amendment filed 4/12/2003 has also been received and entered as paper no. 9.
- (c) Applicant's response to the supplemental restriction made in view of the newly added claims has been received and entered into the file.
- (d) Claims 1-19 and 22-49 have been cancelled.
- (e) Claims 50-56 have been newly added.
- (f) Claims 20-21 and 50-56 are currently pending.
- (g) Applicants claim that the Application is a 371 of PCT/JP00/06302 and to Japanese 11/262470 and Japanese 2000/81823 is acknowledged.

II. Remarks Regarding Restriction:

Applicants have elected to prosecute the inventions of group VII(a), claims 20-21, drawn to the compounds of formula (IV-9) with traverse. The traversal was on the grounds that the non-elected groups are drawn to a process of making and a process of using formula (IV-9) and thus upon the allowance of group VII(a), these non-elected claims should be rejoined in view of In re Ochiai. The examiner agrees with the Applicant, but in view of the rejections cited below, group VII(a) is not allowed and thus rejoinder is premature. Hence, the restriction requirement as outlined is maintained and made FINAL. Consequently, claims 50-56 are withdrawn from consideration as being drawn to non-elected inventions. 37 CFR 1.142(b).

III. Rejections:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20 and 21 are rejected under 35 U.S.C. 102(n) as being anticipated by Heschel, et al (Applicants citation AH reference on 1449).

Applicants claims relate to compounds of formula IV-9 in claim 20. Heschel, et al teaches a compound that anticipates the instant claims where Applicants R13 is Ethyl; R14 is Hydroxymethyl and R6 is Methyl. See abstract attached as it depicts the compound at issue (RN# 114336-01-5).

IV. Objections:

Claims 50-56 are objected to as being drawn to non-elected inventions. 37 CFR 1.142(b).


V. Contact Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small whose telephone number is (703) 305-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:30-6:30 PM. The number for accessing the facsimile machine is (703) 746-4984.

August 8, 2003



Andrea D. Small, Esq.
Patent Examiner
Art Unit 1626, Group 1620